

Nalco Docket No. 7774
Customer No. 49459

REMARKS

Favorable reconsideration in view of this amendment is respectfully requested. Applicants have reviewed the Office Action and respectfully assert that this paper is responsive to all points raised therein.

Claims 1, 12, and 34 have been amended. No new matter has been added.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Office Action rejected Claims 1, 8, 10, 11, and 32 to 37 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner alleges that the basis for the claim term "covalently copolymerized" was not provided in the original specification.

Applicants respectfully traverse this rejection and point the Examiner's attention to at least page 9, lines 15 to 17, of the as-filed Specification. This section reads, "The metal silicate solution is subsequently added to the heel to form the colloid. During particle formation, the OH⁻ present in the heel catalyzes the copolymerization of the cationic metal component and silicate (SiO₄⁻) from the silicic acid."

Nonetheless, without acquiescence and to further prosecution Applicants have amended Claims 1 and 34 to clarify the elements of those claims. Accordingly, Applicants respectfully submit that this rejection has been overcome and respectfully request that this rejection be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(a)

The Office Action rejected Claims 1, 2, 8, 10, 11, 32 to 37 under 35 U.S.C. § 102(a) as being allegedly anticipated by Cundy et al., "Some observations on the preparation and properties of colloidal silicates. Part I: synthesis of colloidal silicalite-I and titanosilicalite-1 (TS-1),"

Nalco Docket No. 7774
Customer No. 49459

Microporous and Mesoporous Materials, 66 (2003): 143 to 156 ("Cundy"). Applicants respectfully traverse this rejection.

Applicants submit herewith a Declaration under 37 C.F.R. § 1.131, signed by coinventor C. Yolanda Ortiz, which shows completion of the claimed invention prior to the December 5, 2003, the effective date of Cundy. To address the Examiner's concerns expressed on page 5, paragraph 9, of the Office Action, Applicants have provided additional explanation of the notebook pages attached as Exhibit A to the Declaration.

Accordingly, in view of the foregoing and the enclosed Declaration, Applicants respectfully request withdrawal of the rejection of Claims 1, 2, 8, 10, 11, 32 to 37.

REQUEST FOR REJOINDER

In the Office Action mailed on September 19, 2006, the Examiner imposed a restriction requirement under 35 U.S.C. § 121 and required Applicants to elect the invention of Group I or Group II for prosecution on the merits. In that Office Action, the Examiner stated that Groups I (Claims 1 to 11, 30, and 31) and II (Claims 12 and 29) are related as a product and process of making the product.

Under MPEP § 821.04, the Examiner should reconsider the propriety of a restriction requirement when all the claims directed to the elected invention are in condition for allowance, and the nonelected invention should be considered for rejoinder. Applicants respectfully submit that all of the non-elected claims in this Application require all of the limitations of the elected claims. Moreover, MPEP § 821.04 further states that claims which depend from or otherwise include all the limitations of the patentable product will be allowed as a matter of right if the amendment is presented prior to final rejection or allowance.

Therefore, Applicants respectfully request reconsideration of the restriction requirement and rejoinder of the withdrawn claims.

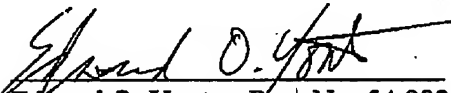
JAN 12 2010

Nalco Docket No. 7774
Customer No. 49459CONCLUSION

In view of the foregoing remarks, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §§ 112, and 102(a). Applicants respectfully assert that all pending claims in this Application are in condition for allowance. Should the Examiner have any questions or comments as to form, content, or entry of this paper, or if any further issues yet to be resolved to advance prosecution of this Application to issue, the Examiner is requested to telephone the undersigned counsel.

Entry of this paper and allowance of all pending Claims 1, 8, 10, 11, and 32 to 37 is respectfully requested. Applicants earnestly solicit early notice to this effect.

Respectfully Submitted,


Edward O. Yonter, Reg. No. 54,882
Nalco Company
Patent and Licensing Department
1601 West Diehl Road
Naperville, IL 60563-1198
Phone: (630) 305-1783

Date: January 12, 2010